

### **REMARKS**

Applicant amended claim 221 to further define Applicant's claimed invention.

In the Office Action, the Examiner indicated that claims 126-130, 207-220, and 236-241 would be allowable if a proper Terminal Disclaimer were submitted. The Examiner also indicated that claim 235 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph and include all the limitations of the base claim and any intervening claims.

The Examiner objected to claims 242-257 under 37 CFR § 1.75 as being substantial duplicates of claims 126-130, 207-213, and 221-241. Applicant respectfully traverses the objection. Independent claim 126 recites the first and second surface projections having "opposed side facets between said forward facet and said rearward facet, said side facets having at least a first portion in a plane passing through and being at an angle to the mid-longitudinal axis of the implant." (See claim 126, fourth paragraph, lines 7-10). Independent claim 242 does not recite any side facets and is of different scope than independent claim 126. Applicant submits that the objection to claims 242-257 has been overcome.

The Examiner rejected all of the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 121-130 of U.S. Application No. 09/572,518 ("the '518 application"). Claims 121-130 have been cancelled from the '518 application by amendment dated January 23, 2004. A copy of the current claims pending in the '518 application is being submitted in an Information Disclosure Statement being filed concurrently herewith. Accordingly, Applicant submits that the double patenting rejection has been overcome.

The Examiner rejected claim 226 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner contends that the recitation "spaced apart from a base of another of said surface projections by a distance no greater than one-half the maximum width" of a surface projection is not supported in the original disclosure. Applicant respectfully

traverses the Examiner's rejection. In Applicant's reply dated September 12, 2003, Applicant identified the support in the original disclosure for the contested recitation in claim 226. (See Applicant's reply of September 12, 2003, page 17, line 3 to page 18, line 7). In particular, Applicant submits that the base of at least one of the surface projections being spaced apart from a base of another of the surface projections by a distance no greater than one-half the maximum width of a surface projection is supported in the original disclosure at least, for example, as shown in Figs. 12 and 15. Surface projection 322 is shown spaced apart from an adjacent surface projection a distance that is less than one-half the width of the surface projection. As set forth in the Summary of the Invention, the "adjacent surface projections can be spaced apart to define a groove therebetween." (Specification, page 4, lines 20-21). The forward facet of a front surface projection and the rearward facet of the next surface projection in a sequence can be spaced apart and the space can be at least in part flat, curved, or any other surface contour suitable for the intended purpose. (Specification, page 5, lines 5-10). The lower-most portion of the left and right side facets 332, 334 of consecutive side-by-side projections 322 can be coincident with each other or may be spaced apart, and any space therebetween can be at least in part flat, curved, sloped, or otherwise configured. (Specification, page 14, lines 2-5).

The figures can provide support for the claimed invention to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. MPEP § 2163(II)(A)(3)(a) states that "[a]n applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, [citation omitted], ("drawings alone may provide a 'written description' of an invention as required by sec. 112"); *In re Wolfensperger*, [citation omitted], (the drawings of applicant's specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, [citation omitted], ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner with the same limitations as the specification.")" (MPEP § 2163(II)(A)(3)(a), page 2100-161, cols. 1 and 2 (August 2001)).

Applicant submits that the description, including the drawings, clearly allows a person of ordinary skill in the art to recognize that Applicant invented what is claimed in claim 226. Accordingly, Applicant submits that the rejection of claim 226 has been overcome.

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims. In particular, the Examiner contends that the recitation of the base of at least one of the surface projections being "spaced apart from a base of another of the surface projections by a distance no greater than one-half the maximum width" as recited in claim 226 is not illustrated. Applicant respectfully traverses the objection. For example only, Figs. 12 and 15 show the distance between the bases of two of surface projections 322 as being no greater than one-half the maximum width of one of surface projections 322. Accordingly, Applicant submits that the objection to the drawings under 37 C.F.R. § 1.83(a) has been overcome.

The Examiner rejected claims 221-234 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,258,125 to Paul et al. ("Paul"). Applicant respectfully traverses the Examiner's rejection. Independent claim 221 recites a method for forming an implant including the step of forming a plurality of surface projections on the upper and lower surfaces of the implant, at least two of the surface projections having a rearward facet with "an included angle greater than 90 degrees between said rearward facet and the base of the surface projection." (Emphasis added).

Paul teaches teeth 12 that are pyramid-shaped and have an included angle between the rearward facet and the base that is less than 90 degrees relative to the surface of the implant. (See, e.g., Paul, Figs. 10A, 10B). In particular, Paul teaches that the angle formed from the tip to the base of teeth 12 is "approximately 60 degrees." (Paul, col. 3, lines 42-44). The 60-degree angle refers to the included angle formed at the base of the pyramid and the rearward facet of tooth 12. The included angle of Paul is not greater than 90 degrees as recited in Applicant's claimed invention. Paul does not teach or suggest an implant having at least two surface projections with a rearward facet having an included angle greater than 90 degrees between the rearward facet and

the base of the surface projection as recited in independent claim 221.

Accordingly, Applicant submits that independent claim 221 is allowable over Paul and that dependent claims 222-234 dependent from independent claim 221, or claims dependent therefrom, are allowable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: February 13, 2004

By: 

Amedeo E. Ferraro  
Registration No. 37,129

1557 Lake O'Pines Street, NE  
Hartville, Ohio 44632  
Telephone: 330-877-0700  
Facsimile: 330-877-2030